

NAKAJIMA -- 09/630,563
Client/Matter: 007874-0271791

REMARKS

Claims 1-29 are pending. By this amendment, the specification is amended. Reconsideration in view of the above amendments and following remarks is respectfully requested.

Applicant has amended the specification to include the claim for priority to PCT/JP99/04178 and PCT/JP00/02015. As this application was filed prior to November 29, 2000, it is respectfully requested that no Petition is due. As both PCT applications designated the United States, under 35 U.S.C. §363 the applications have the effect of national applications for patents regularly filed in the Patent and Trademark Office. Accordingly, no certified copies of the PCT applications are due to perfect Applicant's claim priority.

Acknowledgement of Applicant's claim for priority under 35 U.S.C. §120 is respectfully requested.

With respect to the Information Disclosure Statement filed June 28, 2002, Applicant respectfully notes that Japanese Publications 10-207946, 10-289267 and International Publication WO 98/21677 were submitted with the Information Disclosure Statement (IDS) filed December 28, 2000. A copy of the International Search Report (ISR) was filed with the December 28, 2000 IDS. A copy of Applicant's date-stamped receipt from December 28, 2000 is enclosed. Accordingly, it is respectfully submitted that these references were timely submitted and must be considered.

With respect to U.S. Patent 5,608,778 and Japanese Publication 11-096252, these references were submitted with the June 28, 2002 IDS with a copy of the International Preliminary Examination Report (IPER).

It is respectfully submitted that the relevance of each of the submitted documents has been concisely explained in the ISR and the translation of the ISR (copy enclosed) submitted with the April 10, 2001 IDS. It is also respectfully submitted that each of the cited documents was submitted prior to a first Office Action on the merits and that no fee is due.

As it appears that the Examiner has not received the December 28, 2000 IDS, Applicant will supplement this response with a new IDS including all of the references cited in the December 28, 2000, April 10, 2001, and June 28, 2002 IDS's. As each of the references has been previously submitted, and concisely explained, it is respectfully submitted that no fee would be due for such an IDS.

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The Office Action rejects each of independent claims 1, 3, 20 and 27-29 under 35 U.S.C. §103(a) over Mobile Commerce in view of Official Notice, Dunlap, PR Newswire and Gifford (U.S. Patent 5,724,424). The rejection is respectfully traversed.

With respect to the taking of Official Notice, Applicant respectfully submits that the Examiner has not complied with the requirements for taking of Official Notice as set forth in MPEP §2144.03. Accordingly, Applicant respectfully requests that the Examiner produce documentary evidence to support the assertion that one of ordinary skill in the art investigating payment systems for mobile commerce would employ old and well-known market research practices by at least investigating dominant players in the field of internet commerce payment systems to ascertain company name and capability or withdraw the rejection.

It is also respectfully submitted that the Examiner is misusing the doctrine of Official Notice. As stated in MPEP §2144.03, Official Notice may be taken of facts beyond the record that are capable of instant and unquestionable demonstration as to defy dispute. It is respectfully submitted that the Examiner is alleging that certain features of Applicant's claimed invention would have been obvious to one of ordinary skill in the art. See, for example, page 7, lines 9-14 of the Office Action. Obviousness is a legal conclusion. Official Notice may be taken only for factual questions, not legal conclusions.

MPEP §2143 states "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claimed limitations.

It is respectfully submitted that the rejection fails to establish a *prima facie* case of obviousness as the references fail to disclose all the claimed limitations. There is also no suggestion or motivation either in the references themselves or the knowledge generally available to one of ordinary in the art, to combine the reference teachings in the manner alleged by the Examiner. In particular, it is respectfully submitted that none of the applied prior art discloses or suggests the claimed settlement apparatus which performs these settlement of a transaction.

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Dependent claims 2, 14-19 and 21-26 recite additional features of the invention and are allowable for the same reasons discussed above with respect to independent claims 1, 3, 20 and 27-29 and for the additional features recited therein.

Reconsideration and withdrawal of the rejections of claims 1-29 are respectfully requested.

In view of the above amendments and remarks, Applicant respectfully submits that all the claims are allowable and that the entire application is in condition for allowance.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

PILLSBURY WINTHROP LLP



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Date: February 2, 2004
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Attachments:

Date-Stamped Receipt (December 28, 2000)
International Search Report (ISR) w/translation

RECEIPT FROM PTO FOR INDICATED ITEMS

(Do **NOT** Use for New or Continuing Applications of Any Kind)
Use 2 postcards for all New Appins. (cont/Div/CIP, too)
Use this sheet when filing CPA

Appln. No: 09/630,563	Atty: Glenn J. Perry
First Inventor: NAKAJIMA	Date: December 28, 2000
	Matter No: 271791
	Client No: 7874

ENCLOSED:

☐ Response/Amendment ☐ Cover Sheet ☐ Cited/Listed Documents

☒ Completion Request for R 53(i)/PCT Nat

1 No. of Pages Abstract

62 No. of Pages Spec and Claims

29 No. of Numbered Claims Only

27 No. of Sheets of Drawings (Figs 1-27)

☒ 1 Set Formal ☐ 1 Set Informal ☐ Cover Letter

☐ Declaration ☐ # of pages

☐ Assignment ☐ Cover Sheet

☐ Small Entity Declaration

☐ Extension Petition (PAT-111)

☐ No. of Priority Documents

☐ IDS Letter ☐ Cited Appin(s) ☒ Foreign Sch Rep/OA

☒ ~~PTO-1449~~ ☒ Cited Documents

☐ Issue Fee Transmittal Form PTOL-85(b) + (c)

\$ 350 Fee (Check)

OTHER:

Current DUE DATE: December 28, 2000

(Submit Single Copy Only)

PCT

国際調査報告

(注8条、法施行規則第40、41条)
[PCT18条、PCT規則43、44]

出願人又は代理人 の書類記号 NI-0006PCT	今後の手続きについては、国際調査報告の送付通知様式(PCT/ISA/220) 及び下記5を参照すること。		
国際出願番号 PCT/JPO0/02015	国際出願日 (日.月.年) 29.03.00	優先日 (日.月.年) 02.08.99	
出願人(氏名又は名称) イーマークシステムズ株式会社			

国際調査機関が作成したこの国際調査報告を法施行規則第41条(PCT18条)の規定に従い出願人に送付する。
この写しは国際事務局にも送付される。

この国際調査報告は、全部で 3 ページである。

☐ この調査報告に引用された先行技術文献の写しも添付されている。

1. 国際調査報告の基礎

a. 言語は、下記に示す場合を除くほか、この国際出願がされたものに基づき国際調査を行った。
☐ この国際調査機関に提出された国際出願の翻訳文に基づき国際調査を行った。

b. この国際出願は、ヌクレオチド又はアミノ酸配列を含んでおり、次の配列表に基づき国際調査を行った。
☐ この国際出願に含まれる書面による配列表

☐ この国際出願と共に提出されたフレキシブルディスクによる配列表

☐ 出願後に、この国際調査機関に提出された書面による配列表

☐ 出願後に、この国際調査機関に提出されたフレキシブルディスクによる配列表

☐ 出願後に提出した書面による配列表が出願時における国際出願の開示の範囲を超える事項を含まない旨の陳述書の提出があった。

☐ 書面による配列表に記載した配列とフレキシブルディスクによる配列表に記載した配列が同一である旨の陳述書の提出があった。

2. ☐ 請求の範囲の一部の調査ができない(第I欄参照)。

3. ☐ 発明の単一性が欠如している(第II欄参照)。

4. 発明の名称は ☒ 出願人が提出したものを承認する。

☐ 次に示すように国際調査機関が作成した。

5. 要約は ☒ 出願人が提出したものを承認する。

☐ 第III欄に示されているように、法施行規則第47条(PCT規則38.2(b))の規定により国際調査機関が作成した。出願人は、この国際調査報告の発送の日から1カ月以内にこの国際調査機関に意見を提出することができる。

6. 要約書とともに公表される図は、

第 1 図とする。 ☒ 出願人が示したとおりである。

☐ なし

☐ 出願人は図を示さなかった。

☐ 本図は発明の特徴を一層よく表している。

様式PCT/ISA/210(第1ページ)(1998年7月)

国際調査報告

国際出願番号 PCT/JP00/02015

A. 発明の属する分野の分類 (国際特許分類 (IPC))

Int. Cl.⁷ G06F 19/00 // G06F 15/00

B. 調査を行った分野

調査を行った最小限資料 (国際特許分類 (IPC))

Int. Cl.⁷ G06F19/00, G06F 17/60, G06F 15/00

最小限資料以外の資料で調査を行った分野に含まれるもの

日本国実用新案公報 1926 - 1996 年

日本国公開実用新案公報 1971 - 2000 年

日本国実用新案登録公報 1996 - 2000 年

日本国登録実用新案公報 1994 - 2000 年

国際調査で使用した電子データベース (データベースの名称、調査に使用した用語)

C. 関連すると認められる文献

引用文献の カテゴリー*	引用文献名 及び一部の箇所が関連するときは、その関連する箇所の表示	関連する 請求の範囲の番号
Y	JP, 10-289267, A (ソニーコミュニケーションネットワーク株式会社) 27 10 月. 1998 (27.10.98) (ファミリーなし) 図 24 (S159-S164) を見よ.	1-29
Y	JP, 10-207946, A (有限会社 コンピュータ・コンサルティング) 13 8 月. 1998 (13.08.98) (ファミリーなし) 図 5 (208, 210) を見よ.	1-29

☒ C 欄の続きにも文献が列挙されている。☐ パテントファミリーに関する別紙を参照。

* 引用文献のカテゴリー

「A」 特に関連のある文献ではなく、一般的技術水準を示すもの

「E」 国際出願日前の出願または特許であるが、国際出願日以後に公表されたもの

「L」 優先権主張に疑義を提起する文献又は他の文献の発行日若しくは他の特別な理由を確立するために引用する文献 (理由を付す)

「O」 口頭による開示、使用、展示等に言及する文献

「P」 国際出願日前で、かつ優先権の主張の基礎となる出願

の日の後に公表された文献

「T」 国際出願日又は優先日後に公表された文献であって出願と矛盾するものではなく、発明の原理又は理論の理解のために引用するもの

「X」 特に関連のある文献であって、当該文献のみで発明の新規性又は進歩性がないと考えられるもの

「Y」 特に関連のある文献であって、当該文献と他の 1 以上の文献との、当業者にとって自明である組合せによって進歩性がないと考えられるもの

「&」 同一パテントファミリー文献

国際調査を完了した日

27 06.00

国際調査報告の発送日

25.07.00

国際調査機関の名称及びあて先

日本国特許庁 (ISA/JP)

郵便番号 100-8915

東京都千代田区霞が関三丁目4番3号

特許庁審査官 (権限のある職員)

岡 坂 正 印

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電話番号 03-3581-1101

内線 3561

様式 PCT/ISA/210 (第2ページ) (1998年7月)

国際調査報告

国際出願番号 PCT/JP00/02015

C (続き) 関連すると認められる文献		
引用文献の カテゴリー*	引用文献名 及び一部の箇所が関連するときは、その関連する箇所の表示	関連する 請求の範囲の番号
Y	WO, 98/21677, A1 (松下電器産業株式会社) 22. 5 月. 1998 (22.05.98) & CN, 1212773, A & EP, 910028, A1 & JP, 10-198739, A 図 43 と図 36(b)(d)を見よ.	1-29
Y	WO, 99/09502, A1 (松下電器産業株式会社) 25. 2 月. 1999 (25.02.99) & AU, 98-86484, A1 & CN, 1246941, T & EP, 950968, A1 図 84 と図 135(b)(d)を見よ.	1-29
A	GIFFORD, David K <i>et al.</i> , "Payment Switches for Open Networks", in <i>Proceedings of the Third ACM Conference on Computer and Communications Security (COMPCON '95)</i> , pp 26-31. 28 ページ (payment URL の構造の説明)を見よ.	1-29
A	WO, 97/49074, A1 (VeriFone, Incorporated) 24. 12 月. 1997 (24.12.97) & AU, 97-36406, A1 & US, 5889863, A "URL Descriptions" と "Thread-Safe vPOS-TID Allocation" の セクションを見よ.	1-29

様式 PCT/ISA/210 (第2ページの続き) (1998年7月)

INTERNATIONAL SEARCH REPORT

International application No.

PCT/JP00/02015

A. CLASSIFICATION OF SUBJECT MATTER

Int.Cl.⁷ G06F 19/00 // G06F 157:00

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)
Int.Cl.⁷ G06F19/00, G06F 17/60, G06F 15/00Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched
Jitsuyo Shinan Koho 1926-1996 Jitsuyo Shinan Toroku Koho 1996-2000
Kokai Jitsuyo Shinan Koho 1971-2000 Toroku Jitsuyo Shinan Koho 1994-2000

Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No
Y	JP, 10-289267, A (Sony Communication Network K.K.), 27 October, 1998 (27.10.98) (Family: none) Fig. 24 (S159-S164)	1-29
Y	JP, 10-207946, A (Computer Consulting K.K.), 13 August, 1998 (13.08.98) (Family: none) Fig. 5 (208,210)	1-29
Y	WO, 98/21677, A1 (Matsushita Electric Ind. Co., Ltd.), 22 May, 1998 (22.05.98) & CN, 1212773, A & EP, 910028, A1 & JP, 10-198739, A Figs. 43, 36(b) (d)	1-29
Y	WO, 99/09502, A1 (Matsushita Electric Ind. Co., Ltd.), 25 February, 1999 (25.02.99) & AU, 98-86484, A1 & CN, 1246941, T & EP, 950968, A1 Figs. 84, 135(b) (d)	1-29
A	GIFFORD, David K et al. "Payment Switches for Open Networks",	1-29

☒ Further documents are listed in the continuation of Box C.☐ See patent family annex

* Special categories of cited documents:

"A" document defining the general state of the art which is not considered to be of particular relevance

"E" earlier document but published on or after the international filing date

"I" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)

"O" document referring to an oral disclosure, use, exhibition or other means

"P" document published prior to the international filing date but later than the priority date claimed

"T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention

"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone

"Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art

"&" document member of the same patent family

Date of the actual completion of the international search
27 June, 2000 (27.06.00)Date of mailing of the international search report
25 July, 2000 (25.07.00)Name and mailing address of the ISA/
Japanese Patent Office

Authorized officer

Facsimile No.

Telephone No.

Form PCT/ISA/210 (second sheet) (July 1992)

INTERNATIONAL SEARCH REPORT

International application No.

PCT/JP00/02015

C (Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT		
Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A	<p>in Proceedings of the Third ACM Conference on Computer and Communications Security (COMPCON '95), pp. 26-31, page 28 (explanation of structure of payment URL)</p> <p>WO. 97/49074, A1 (VeriFone, Incorporated), 24 December, 1997 (24.12.97) & AU, 97-36406, A1 & US, 5889863, A Sections, "URL Descriptions" and "Thread-Safe vPOS-TID Allocation"</p>	1-29

Form PCT/ISA/210 (continuation of second sheet) (July 1992)